

REMARKS

This is in response to the fourth Office Action, dated January 10, 2003, where the Examiner has rejected claims 1 and 4-53. After the present response, claims 1 and 4-53 are pending in the present application. Reconsideration and allowance of pending claims 1 and 4-53 in view of the following remarks are respectfully requested.

A. Rejection of Claims 1 and 4-53 under 35 U.S.C. § 102(e)

The Examiner has rejected claims 1 and 4-53 under 35 U.S.C. § 102(e), as being anticipated by Shima (USPN 6,333,789). Applicants respectfully disagree.

In response to the previous Office Action, applicants submitted affidavits under 37 C.F.R. § 1.131 to swear behind Shima; however, in the present Office Action, the Examiner has found the evidence submitted by applicants insufficient for swearing behind the effective date of Shima.

To explain applicants' position, a brief telephonic conversation was conducted with the Examiner on March 5, 2003. Applicants would like to extend their gratitude to the Examiner for his time and the courteous conversation regarding this matter. As mentioned, applicants respectfully submit that the Examiner's analysis in the present Office Action is not in accordance with the well-settled law, as explained below.

In finding applicants' evidence insufficient with respect to claim 1, the Examiner states: "the innovation disclosure makes no mention of the modem comprising more than one physical channels" and, also, it "makes no mention of defining the first logical channel according to a command type in the command information nor defining the second logical channel according to a data type in the data information."

Applicants respectfully submit that the Examiner's approach is misguided, because the Examiner has focused on finding support for each and every element of claim 1 in the innovation disclosure (which has been submitted as corroborative evidence of conception). Applicants refer the Examiner to *In re Zletz*, 893 F.2d 319, 13 U.S.P.Q.2D 1320 (Fed. Cir. 1989) citing *In re Stempel*, 44 C.C.P.A. 820, 241 F.2d 755, 759-60, 113 U.S.P.Q. (BNA) 77, 81 (1957) (discussing what is necessary to successfully "swear back" of a reference under Rule 131, when the reference discloses a species of the applicant's generic claim). In *in re Stempel*, the court states:

What the Board is here saying, in effect, is that the invention, the completion of which must be shown by a Rule 131 affidavit, is the invention defined in the claim the applicant is asking for and, if it is a generic claim, prior completion of the generic invention must be shown, whether or not the reference discloses the generic invention.

We think this is a too literal construction of the rule and not in accord with past practice. See *Ex parte Burt* and *Ex parte Clifford*, supra. **We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference.** (emphasis added.) 44 C.C.P.A. at 826.

Accordingly, applicants respectfully submit that the Examiner's focus on finding support for each and every element of the claims in the innovation disclosure is misplaced. Rather, all applicants need to show is that Shima does not show anything more than what the innovation disclosure (i.e. applicants' evidence under 37 CFR 131) discloses, teaches or suggests to one of ordinary skill in the art with respect to the claims at issue.

For example, the Examiner has cited an excerpt from Shima at col. 9, line 63 to col. 10, line 6, to show first logical channel for sending print data and a second logical channel for sending control command. Applicants respectfully submit that the innovation disclosure states "This new solution turns one physical channel into two logical channels" and "by reserving one

channel number for commands, and another for data, the information's destination can be indicated." Accordingly, Shima does not disclose, teach or suggest anything more than the innovation disclosure and, thus, the innovation disclosure is sufficient evidence to overcome the cited reference. (See also MPEP § 715.02 "an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971.)

Furthermore, MPEP § 715.02 states:

Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art.

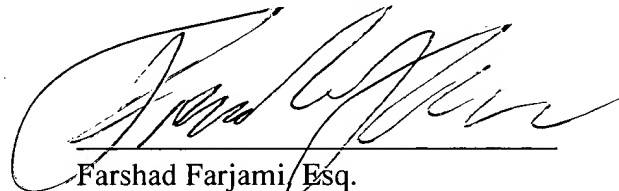
In light of the above excerpt from the MPEP, applicants respectfully submit that, for example, the Examiner's statement that "the innovation disclosure makes no mention of the modem comprising more than one physical channels" is also improper, since the innovation disclosure discloses one physical channel having two logical channels (one logical data channel and one logical command channel), and it would have been obvious to one of ordinary skill in the art that an embodiment of the invention could include more than one physical channel or more than two logical channels.

Accordingly, applicants respectfully submit that the Examiner's rejection based on Shima should be withdrawn, and claims 1 and 4-53 should be allowed.

B. Conclusion

For all the foregoing reasons, an early allowance and issuance of claims 1 and 4-53 pending in the present application are respectfully requested. The Examiner is invited to contact the undersigned for any questions.

Respectfully Submitted;
FARJAMI & FARJAMI LLP



Farshad Farjami, Esq.
Reg. No. 41,014

Farshad Farjami, Esq.
FARJAMI & FARJAMI LLP
16148 Sand Canyon
Irvine, California 92618
Tel: (949) 784-4600
Fax: (949) 784-4601

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Lori Llave
Name

Lori Llave
Signature